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*Intellectual Property Law
Technology Transfer
Trademarks
Copyrights
Patents*

January 25, 2006

Clerk of Court
United States Court of Appeals for the Federal Circuit
717 Madison Place, NW
Washington, DC 20439

Re: NOTICE OF APPEAL
USPTO, Trademark Trial and Appeal Board Decision, 29 November 2005
MISSIONTREK LTD. CO., Appellant, vs. ONFOLIO, INC., Appellee

To the Honorable Clerk of Court:

Enclosed for filing please find four copies of a Notice of Appeal along with a check in the amount of \$250.00 with regard to the above referenced matter. Attached is a copy of the decision/order that is the basis of this appeal. Please forward to the Court in your usual manner.

After filing the Notice of Appeal please return a file-marked copy in the self addressed and stamped envelope.

Thank you for all of your help regarding this matter. If you have any questions, please do not hesitate to contact this office.

Respectfully submitted,

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Clerk of the Court
January 25, 2006
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cc: Mr. Charles E. Weinstein, Via CMRRR 7005 2570 0002 2811 4246

General Counsel

United States Patent & Trademark Office, Via CMRRR 7005 2570 0002 2811 6557

Trademark Trial and Appeal Board

Commissioner for Trademarks, Via CMRRR 7005 2570 0002 2811 6394

CERTIFICATE OF FIRST CLASS MAILING

UNDER 37 CFR §§1.8 or 2.197

I, Lorraine Beahan, certify that this material will be deposited with the United States Postal Service as first class mail with proper postage affixed in an envelope addressed to "The US Patent & Trademark Office" or "Commissioner for Trademarks" on the date below.

Date: 1/25/06

Signed: Lorraine Beahan

United States Court of Appeals for the Federal Circuit

MISSIONTREK LTD. CO., § Appellant (Petitioner/Opposer),

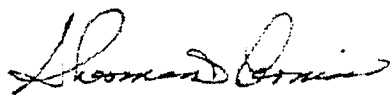
vs.

NOTICE OF APPEAL

ONFOLIO, INC., § Appellee (Registrant/Applicant).

MISSIONTREK LTD. CO. hereby appeals to the Court for review of the decision/order of the U.S. Patent & Trademark Office, Trademark Trial & Appeal Board entered on November 29, 2005 in the above styled case. Attached is a copy of the decision/order that is Appellant's basis for this appeal (in Cancellation No. 92044538 & Opposition No. 91165315, consolidated).

Respectfully submitted,



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Certificate of Service

I hereby certify that a true copy of the above Notice was served on the Appellee's attorney of record, on the General Counsel U.S. Patent and Trademark Office, and on the Trademark Trial and Appeal Board, in accordance with the Federal Rules of Appellate Procedure on 25 January 2006.

Mr. Charles E. Weinstein
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**THIS OPINION IS NOT CITABLE
AS PRECEDENT OF
THE T.T.A.B.**

**UNITED STATES PATENT AND TRADEMARK
OFFICE**
Trademark Trial and Appeal Board
P.O. Box 1451
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Butler

Mailed: November 29, 2005

Opposition No. 91165315
Cancellation No. 92044538

Missiontrek Ltd. Co.

v.

Onfolio, Inc.

Before Hairston, Chapman and Kuhlke, Administrative Trademark
Judges.

By the Board:

Plaintiff seeks to cancel defendant's registration of the
mark ONFOLIO for "computer software for capturing, organizing and
sharing on-line content."¹ Plaintiff opposes registration of
defendant's mark shown below

ONFOLIO

also for "computer software for capturing, organizing and sharing
on-line content."² As grounds for the complaints, plaintiff
alleges that defendant's marks, when used on the identified
goods, so resemble plaintiff's previously used and registered

¹ Registration No. 2904982, issued November 23, 2004, claiming use and
use in commerce since December 4, 2003. This registration is the
subject of Cancellation No. 92044538.

² Application Serial No. 78360232, filed January 30, 2004 pursuant to
Trademark Act §1(a), claiming use and use in commerce since December
4, 2003. This application is the subject of Opposition No. 91165315.

mark CARTAGIO as to be likely to cause confusion, mistake or to deceive. Plaintiff further alleges that its CARTAGIO mark is registered for "computer software, namely internet navigation software, that is, internet browsers; computer hardware in the nature of database and computer management equipment; internet research and cost accounting software; software for hosting computer servers, and user manuals sold as a unit."³ More particularly, plaintiff alleges that the marks are similar because they both begin with round letters ("C" and "O"); end in the same letters "IO"; "have the same number of letters"; and, when spoken, have the same number of syllables and the same accent.

This case now comes up on defendant's nearly identical motions for summary judgment, filed in each proceeding on July 5, 2005. Defendant's motions were filed prior to the due dates for its answer in each case. Plaintiff filed nearly identical responses to the summary judgment motions, and defendant replied thereto in each case. Before turning to the summary judgment motions, the Board addresses some preliminary matters.

The Board has reviewed both of the above-identified proceedings and finds that consolidation is appropriate inasmuch as the two proceedings involve the same parties and common questions of law and fact. Consolidation may be ordered on the Board's own initiative. See Fed. R. Civ. P. 42(a); *Regatta*

³ Registration No. 2756245, issued August 26, 2003, and claiming use and use in commerce since September 15, 2001.

Opposition No. 91165315 and Cancellation No. 92044538

Sports Ltd. v. Telux-Pioneer, Inc., 20 USPQ2d 1154 (TTAB 1991); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991); and TBMP §511 (2d ed. rev. 2004). The Board may exercise its discretion in ordering consolidation prior to joinder of issue (*i.e.*, before an answer has been filed in each case). See TBMP §511 (2d ed. rev. 2004). Here we find consolidation prior to joinder of issue is appropriate.

Accordingly, Opposition No. 91165315 and Cancellation No. 92044538 are hereby consolidated and may be presented on the same records and briefs. The record will be maintained in Opposition No. 91165315 as the "parent" case, but all papers filed in these cases should include both proceeding numbers in the order shown in the caption of this consolidated case.

Plaintiff separately sought to suspend both proceedings pending disposition of a third-party cancellation proceeding (Cancellation No. 92044856 between plaintiff herein, as petitioner, and Peter Cordes, as defendant). This latter proceeding involves a registration for the mark PROVISIO. Plaintiff's motion to suspend, filed on September 21, 2005 in Cancellation No. 92044538, was denied by order of the Board dated September 23, 2005. In denying the motion, the Board determined that plaintiff "utterly fail[ed] to demonstrate that Cancellation No. 92044856 has anything to do with this proceeding, except that petitioner happens to be involved in both cases." (Emphasis in the original.) Plaintiff's motion to suspend, filed August 24,

Opposition No. 91165315 and Cancellation No. 92044538

2005 in Opposition No. 91165315 is hereby denied for the same reasons.

For purposes of its summary judgment motions,⁴ defendant concedes the relatedness of the parties' respective goods. Defendant clarifies that it seeks judgment in its favor as a matter of law on the premise that the involved marks are so dissimilar that there is no likelihood of confusion.

In support of its motion, defendant argues that no genuine issues of material fact exist as to likelihood of confusion because the marks are completely distinct in sound, appearance, connotation, and commercial impression; and that the dissimilarity of the marks so outweighs the other *DuPont* factors⁵ that it is dispositive. Defendant argues that the involved marks do not, as plaintiff alleges, have the same number of letters; that the only common element in the parties' respective marks is the suffix "IO," which is an ordinary English language suffix found in numerous registered marks for hardware and software; that such suffix is derived from Latin, a constituent language of English; and that "IO" is "added to the stem of the perfect passive participle of a verb to create a verbal noun indicating an action." Defendant contends that the marks, when spoken, are significantly different in pronunciation and, thus, do not sound alike or even similar. Defendant argues that the root terms of

⁴ The summary judgment motions may be referred to in the singular, *infra*.

⁵ See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

each party's marks differ, with plaintiff admitting, in response to the Examining Attorney's inquiry as to any meaning of the term CARTAGIO (at the time that pleaded Registration No. 2756245 was pending as an application), that there is no translation of the term and that "... CARTAGIO has no known meaning, other than its being similar to an old Latin name of the city of Carthage, Tunisia." Defendant contends that the root of its marks, FOLIO, on the other hand, means "a leaf of paper ..., a leaf-number of a book, a sheet of paper folded once, making two leaves of a book, [or] a book made of such sheets." Thus, because the marks suggest different meanings, defendant argues that the marks have different commercial impressions, arguing further that its ONFOLIO marks are likely to be seen as a variant of the term "portfolio." Defendant also points out that the design element of one of its marks further supports the visual dissimilarities between plaintiff's mark and defendant's ONFOLIO and design mark.

Defendant's motion is accompanied by excerpts from an on-line dictionary definition of the suffix "io"; a listing from Thomson CompuMark of registrations and pending applications of marks containing terms ending in "io"; USPTO's TARR printouts of registered marks containing terms ending in "io"; a copy of plaintiff's response to the Examining Attorney's inquiry as to whether CARTAGIO has any translation or meaning; and a dictionary definition of the term "folio."

In response, plaintiff argues that actual confusion exists based on a survey it conducted which demonstrated that "... 25% of

the respondents indicated that the product names are so similar that it is likely that the products come from the same source"; and that defendant's motion must fail because defendant did not "... identify the elements of its adversary's case with respect to which it considers there to be a deficiency of proof." Plaintiff further contends that the marks, when written, look similar because the beginning and ending letters are round (C/O vs. O/O); that when spoken aloud, the accents on the words are similar; and that, when written in lower case, "... there are two letters in the middle portion of the marks having appendages that extend beyond the normal limits of a lower-case letter, namely the T and G of Cartagio, and the F and L of Onfolio." Plaintiff argues that its mark is well-established, though it states it does not know whether its mark is famous; and that defendant is the junior user, who adopted a similar mark for closely related goods and did not exercise good faith in avoiding the rights of others, particularly its competitors' pre-existing products.⁶ Plaintiff's response is accompanied by the declaration of its director concerning the survey conducted and a copy of the survey inquiry sent to the recipients by email.

In reply, defendant argues that it did present adequately the elements forming the basis of its summary judgment motion;

⁶ Plaintiff, at page 5 of its response to defendant's motion for summary judgment, requests discovery. To the extent, if any, that plaintiff seeks discovery pursuant to Fed. R. Civ. P. 56(f), such request is denied inasmuch as plaintiff responded on the merits to defendant's motion for summary judgment. See *Ron Cauldwell Jewelry, Inc. v. Clothesline Clothes, Inc.*, 63 USPQ2d 2009 (TTAB 2002).

and that plaintiff's arguments concerning the similarities of the marks are "peculiar" and without support. Defendant contends that plaintiff's survey is not entitled to any consideration because it is inexpert and biased in design and administration; it fails to specify or provide any information regarding the respondents; it fails to provide the actual responses; it fails to approximate actual market conditions; it fails to present defendant's design mark; and it makes leading inquiries.

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issues of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c). A genuine issue with respect to material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any factual issues are genuinely in dispute must be resolved against the moving party and all inferences must be viewed in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

In the present case, the Board finds that defendant has established the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. The circumstances here are similar to those in *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d

1459 (Fed. Cir. 1998) and *Kellogg Co. v. Pack'em Enterprises, Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991), in that the single *DuPont* factor of the dissimilarity of the marks in their entireties substantially outweighs any other relevant factors and is dispositive of the issue of likelihood of confusion.

Moreover, we find that plaintiff's survey does not raise a genuine issue of material fact with respect to the similarities of the parties' respective marks. According to the statement of plaintiff's director, he:

... prepared an email survey of 42 persons who had recently downloaded our CARTAGIO software and who otherwise were believed to be able to provide Petitioner with an objective opinion on the issue of likelihood of confusion.

Of the 42 emails sent, 8 responses to the question were received. Of these 8 responses, two indicated actual confusion and six indicated no confusion. Of those that indicated actual confusion, one is a manager of a software sales company and may have already known about ONFOLIO, so, perhaps, his response indicating no confusion can be ignored. In any case, still counting this one likely invalid response, **a full 25% of those surveyed indicated confusion.** (Emphasis in the original.)

The inquiry sent by plaintiff's director, asks the following:

With respect to a recently released online research/knowledge management product, called ONFOLIO, which of the below statements is most likely to be true?

- a. Because the product names are similar, ONFOLIO is likely a licensee of Missiontrek, the developer of CARTAGIO.
- b. Because the product names are similar, ONFOLIO is likely a product of Missiontrek, adapted for a particular niche market.
- c. I see no similarity at all. Consequently, there is likely no relationship between the products.

The number of respondents (2) that indicated they may be confused *vis-à-vis* the number of acknowledged inquiries sent (42) mathematically does not amount to the inflated percentage calculated by plaintiff (25%) of respondents possibly confused. We observe, too, that the survey, at a minimum, is not based on established or recognized survey techniques; was prepared and administered by a biased party; and was not analyzed in any statistically meaningful way. See, for example, *Hilson Research, Inc. v. Society for Human Resources Management*, 27 USPQ2d 1423 (TTAB 1993); and 5 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition §§32.158-32.196 (4th ed. 2005).

Accordingly, defendant's motions for summary judgment are granted; judgment is entered against plaintiff in both proceedings; Opposition No. 91165315 is dismissed with prejudice; and Cancellation No. 92044538 is denied with prejudice.
